

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS BENNETT GILBERG

Appeal No. 2003-2109
Application 09/989,330

ORDER REMANDING TO EXAMINER

On March 27, 2003, appellant filed a Notice of Appeal (Paper No. 11) "from the last decision of the examiner [Final Rejection mailed December 18, 2002 (Paper No. 8) stating that "[c]laims 1-32 is/are pending in the application"]. The Appeal Brief filed May 14, 2003 (Paper No. 12) also stated that "[c]laims 1-32 are pending in the application" [page 2 under the

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heading "(3) Status of Claims". However, the "Grounds of Rejection" appearing on pages 3-5 of the Examiner's Answer mailed June 23, 2003 (Paper No. 13) state:

Claims 1 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillinder (US 715,571);

Claims 12-13 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillinder in view of DiLernia (5,867,938) and further in view of Gates (6,179,218); and

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillinder in view of Satterlee Nursery

It should be noted that the Examiner's Answer mailed June 23, 2003 (Paper No. 13) fails to specifically address the rejection of claims 2-11, 14-16, 18-27, 31 and 32. Correction is required. In addition, section 1208 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003) states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

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Lastly, on August 20, 2003, a "Reply Brief of Applicant Under 37 C.F.R. § 1.193(b)" (Paper No. 15) was filed in response to the Examiner's Answer mailed June 23, 2003 (Paper No. 13) and has been matched with this application at the Board of Patent Appeals and Interferences. However, there is no indication in the record of whether or not the examiner has considered this paper.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for clarification regarding the rejection of claims 2-11, 14-16, 18-27, 31 and 32;
2. for taking corrective action regarding the appeals conference;
3. for proper response to the "Reply Brief of Applicant Under 37 CFR § 1.193(b)" filed August 20, 2003 (Paper No. 15); and
4. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the

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status of the appeal (i.e., abandonment, issue, reopening
prosecution).

BOARD OF PATENT APPEALS
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